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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/864,155	05/25/2001	Jonathan Whitman	9566-001-27	1451

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Supervisor, Patent Prosecution Services
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EXAMINER

RHODE JR, ROBERT E

ART UNIT PAPER NUMBER

3625

DATE MAILED: 03/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/864,155

Applicant(s)

WHITMAN, JONATHAN

Examiner

Rob Rhode

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-56 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 May 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

DETAILED ACTION

Drawings

The drawings filed on 05/25/2001 are acceptable subject to correction of the informalities indicated on the attached "Notice of Draftperson's Patent Drawing Review," PTO-948. Additionally, the computer screens in Figure 1 and all shaded flow charts Figures must not be shaded. In order to avoid abandonment of this application, correction is required in reply to the Office action. The correction will not be held in abeyance.

Specification

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

In Claims 1 – 32 and 55, the claimed invention is directed to non-statutory subject matter. The claim is directed to a process that does nothing more than manipulate an abstract idea. There is no practical application in the technological arts. See In re

Musgrave, 167 USPQ 280 (CCPA 1970) and In re Johnston, 183 USPQ 172 (CCPA 1974). For example in claim 1, the invention in the body of the claim does not recite the use of nor incorporate any technology in carrying out the recited method steps and therefore is not statutory. If the invention in the body of the claim is not tied to the technological arts, environment or machine, the claim is not statutory. See Ex parte Bowman, 61 USPQ2d 1665, 1671 (BD. Pat. App. & Inter. 2001) [Unpublished] and note MPEP 2106 IV 2(b). While Bowman is not precedential, it has been cited for its analysis.

Claim Rejections - 35 USC § 102

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1 – 56 are rejected under 35 U.S.C. 102(a) as being unpatentable over “The Point of No Returns”, Industry Standard; Oreskovic, Alexei; Mar 20, 2000 with screen print outs of “returnexchange.com” captured via the WayBackMachine (archieve.org)[hereafter referred to as “Exchange”].

Regarding claim 1 and related claim 55, Exchange teaches a method for providing return of items via a network and via an item return location, the method comprising: receiving a selection to return an item (see at least Page 5); receiving information relating to the item to be returned (see at least Page 5); determining return information for the item from the received information relating to the item to be returned (see at least Page 5); assigning coded information relating to the item to be returned, the coded information being associated with the determined return information (see at least Page

5); transmitting the coded information via the network, the coded information to be provided with return of the item (see at least Page 4 and 5); at the item return location, reading the provided coded information; accessing the determined return information (see at least Page 4 and 5); and evaluating the item for return based on the determined return information (Pages 4, 5 and 6).

Regarding claim 2 and related claim 34, Exchange teaches a method, wherein the information relating to the item to be returned includes information about a returnee (Pages 1 and 5).

Regarding claim 3 and related claim 35, Exchange teaches a method, wherein the return information includes a determination whether the item is returnable (Pages 1, 4 and 5).

Regarding claim 4 and related claims 22 and 36, Exchange teaches a method, wherein the item to be returned includes components, and wherein the information relating to the item to be returned includes a list of the components (Pages 1 – 6). Please note that Exchange does not specifically disclose a list of components. However, Exchange does teach regarding conditions of returned merchandise and it would have been obvious to one of ordinary skill in the art that a condition would include a list of components. For example, a set of silver ware returned would have a list of the components on the box and at the return center it would be confirmed.

Regarding claim 5 and related claims 7 and 37, Exchange teaches a method, wherein determining return information for the item from the received information relating to the item to be returned comprises: determining whether the item is opened (Page 1 – 6).

Please note as discussed above in claim 5, determining if the package of silver ware – its condition would include open. Thereby, it would have been obvious to one of ordinary skill in the art that to include in checking the condition of package would have included determining whether the package was open or not.

Regarding claim 6 and related claims 8, 38 – 40, Exchange teaches a method, wherein determining return information for the item from the received information relating to the item to be returned comprises: determining whether the item is damaged. Please note and as with claims 5 and 6, this too would be an obvious variation.

Regarding claim 9 and related claims 12 – 15 and 41, 43 - 45, Exchange teaches a 9 method, wherein the coded information comprises a bar code. It is old and well known that merchandise includes bar codes. Please see Veenman (US 5,754,981).

Regarding claim 10 and related claim 42, Exchange teaches a method, wherein the coded information comprises a printable form (Page 5).

Regarding claim 11, Exchange teaches a method, wherein transmitting the coded information via the network comprises: transmitting the coded information to a terminal (Page 1 and 5).

Regarding claim 16 and related claims 32 and 46, Exchange teaches a method, wherein the network is the Internet (Page 5).

Regarding claim 17 and related claim 18, Exchange teaches a method, further comprising: storing the received information relating to the item to be returned (Pages 1, 4 and 5). Please note that in online methods and systems for "storing" of information that a kind/type including such specifics as relating "to the item being returned" is given little patentable weight. The phrase(s) and or word(s) are given little patentable weight because the claim language limitation is considered to be non-functional descriptive material, which does not patentably distinguish the applicant's invention from Exchange. Thereby, the non-functional descriptive material is directed only to the content of the data (. i.e. to the item being returned - which is stored data) and does not affect either the structure or method/process of Exchange, which leaves the method and system unchanged.

Regarding claim 19 and related claim 29, Exchange teaches a method, wherein the determined return information is stored in a repository (Page 1, 4 and 5). Please note that for examination purposes the word repository is equated to a database.

Regarding claim 20 and related claim 54, Exchange teaches a method, wherein the repository comprises a database (Page 1).

Regarding claim 21 and related claim 52, Exchange teaches a method, wherein accessing the determined return information comprises: retrieving the determined return information from the repository (Page 1 and 5).

Regarding claim 23, Exchange teaches a method, further comprising: if the item is opened, auctioning the item (Pages 4 and 7).

Regarding claim 24, the recitation that "wherein the item is auctioned using a reverse auction", such recitation is given little patentable weight because it imparts no structural or functional specificity which serves to patentably distinguish the instant invention from the other "auction" already disclosed by Exchange. Moreover, reverse auctions are old and well known to one of ordinary skill in the art.

Regarding claim 25 and related claim 26, Exchange teaches a method, further comprising: if the item is returnable, warehousing the item (Page 4 and 6).

Regarding claim 27, Exchange teaches a method, further comprising: if the item is not opened, shipping the item to a customer. Please note that Exchange does not

specifically disclose shipping the unopened item to the customer. However and if a customer - who just returned the merchandise wanted it back later. It would be obvious that Exchange could also do the shipping to the customer since it has return capability of merchandise to all marketing channels.

Regarding claim 28, Exchange teaches a method, wherein the determined return information includes disposition instructions for the item and (30), wherein the item is sold by a merchant (Pages 1, 5 and 6).

Regarding claim 31, Exchange teaches a method, further comprising: providing access for the merchant to the repository (Page 1) and (32), wherein the repository is accessible via the network (Pages 1 and 2).

Regarding claim 47 and related claims 48 - 53, Exchange teaches a system, wherein the at least one terminal is coupled to the network via a coupling and (48) wherein the coupling comprises one from a group consisting of a wired connection, a wireless connection, and a fiber optic connection (Pages 1 and 5). Please note that Exchange does not specifically disclose connections, or personal computer or that a server could be a personal computer. However, it is old and well known that these devices were required in order to have a fully functioning online method and system, which is taught by Exchange. Thereby, it would have been obvious to have provided these devices and

incorporated into Exchange in order to have a fully functioning online/internet based Return Exchange.

Regarding claims 33 and related claim 56, these systems claims are rejected as well as not being patentable over Exchange and the same reference pages apply.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art is screen prints of returnbuy.com captured via the WayBackMachine (archive.org) and dated August 16, 2000 and please note that the founding date of returnbuy was 1999 and "Smartship.com Gains Approval From United States Postal Service to provide e-tailers With Merchandise Return Service"; Business Wire; April 12, 2000, which all address online return of merchandise.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rob Rhode whose telephone number is 703.305.8230. The examiner can normally be reached on M-F 7:30am - 4:00pm.

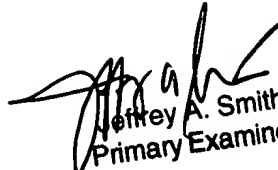
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 703.308.3588. The fax phone number for the organization where this application or proceeding is assigned is 703.872.9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.306.1113.

RER


Jeffrey A. Smith
Primary Examiner